



UNITED STATES PATENT and TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

JAN 28 2003

Mailed:

td
Paper Number 8

In re application of
Hiramatsu et al.
Serial No. 09/817,251
Filed: March 27, 2001
For: METHOD FOR STIRRING LIQUID

:
:
: DECISION ON
: PETITION
:

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed November 6, 2002.

On February 15, 2002, a non-final office action was mailed to applicant rejecting all of the claims under 35 USC 102 and/or 35 USC 103. A reply to the office action was filed by applicants on August 15, 2002. In the reply, applicants made several amendments to the claims. A final office action was mailed by the office on November 6, 2002 containing new grounds of rejection. Applicants made a request to the examiner to withdraw the finality of the November 6, 2002 office action. This request was denied.

On December 18, 2002 the instant petition under 37 CFR 1.181 was timely filed to formally request the withdrawal of finality of the November 6, 2002 office action.

Petitioner's position for the withdrawal of the finality is that the new grounds of rejection in the final office action were not necessitated by applicant's amendments to the claims.

DECISION

Section 706.07 of the MPEP states:

706.07(a) Final Rejection, When Proper on Second Action

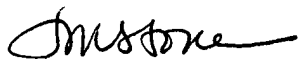
Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Petitioner argues that because claims 6 and 8 were not rejected over the Hargen reference in the first office action and then newly rejected over this reference in the final office action, the rejection was improperly made final. Claim 6 is a dependent claim of claim 1. Claim 8 is an independent claim. Claim 1 was rejected over the Hargen reference in the non-final office action under 35 USC 102 as being anticipated. In the amendment filed by applicants, claim 1 was narrowed. The examiner maintained the rejection of claim 1 over Hargen in the final office action and added a rejection of claim 6 under 35 USC 103 over this reference. It is noted that the examiner rejected claim 6 under 35

USC 102 over a separate reference in the non-final office action. The amendment filed by applicant overcame this rejection and required the examiner to apply a 35 USC 103 rejection to claim 6. The fact that the examiner did not reject claim 6 over Hargen in the non-final office action does not make petitioner's argument persuasive because the examiner rejected the claim using 35 USC 102, which is a stronger rejection than a 35 USC 103 rejection. Any 35 USC 103 rejection would have been merely cumulative and unnecessary. With respect to independent claim 8, this claim was not rejected over Hargen in the non-final office action. The claim was narrowed in the amendment filed and then rejected over Hargen in the final office action. Because the Hargen reference was applicable to the narrower amended claim, the claim should have been rejected over Hargen in the non-final office action. Therefore, the non-final office action mailed February 15, 2002 was incomplete. Petitioner's argument that the new grounds of rejection were not necessitated by Applicant's amendments are persuasive.

Because the rejection of claim 8 based on a new ground of rejection was improper, the finality of the office action was premature. Accordingly, the petition for withdrawal of finality is **GRANTED**.

It is also pointed out that while the finality of the office action has been withdrawn, the rejection still stands. Applicant's time for response continues to run from November 6, 2002. Extensions of time may be obtained to file any amendments.



Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, N.W.
Washington DC 20037